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TELEFAX

Date: February 8, 2006	Total pages: 19 with fax cover	
To: USPTO	Telephone:	Telefax: 571-273-8300
From: Tiffany Salmon	Telephone: 404-879-2153	Telefax: 404-879-2160
Our Docket No. MIT 6620 CIP	Client/Matter No. 095148/19	
Your Docket No.		

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MESSAGE:**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****Applicant:** Monty Krieger and Susan L. Acton**Serial No.:** 08/765,108**Art Unit:** 1649**Filed:** March 27, 1997**Examiner:** Michael T. Brannock**For:** *CLASS B1 AND C1 SCAVENGER RECEPTORS*

Attachments: Transmittal Form PTO/SB/21, Fee Transmittal Form PTO/SB/17, Response to Request by the Examiner for Sequence Listing Diskette and Support for Inventorship with copies of Preliminary Amendment mailed 12/23/1996 and Office Action mailed 3/5/02.

(45064257.1)

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0851-0031

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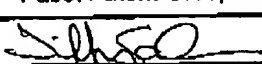
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	08/765,108	
	Filing Date	March 27, 1997	
	First Named Inventor	Monty Krieger	
	Art Unit	1649	
	Examiner Name	Michael T. Brannock	
Total Number of Pages in This Submission	18	Attorney Docket Number	MIT 6620 CIP

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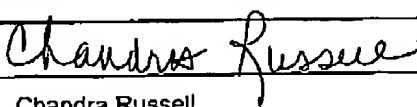
ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Response to Request by the Examiner for Sequence Listing Diskette and Support for Inventorship; copies of Preliminary Amendment filed 12/23/1996 and Office Action mailed 3/5/02
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Pabst Patent Group LLP		
Signature			
Printed name	Tiffany B. Salmon		
Date	February 8, 2006	Reg. No.	55,589

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Chandra Russell	Date	February 8, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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MIT 6620 CIP 095148/19

PTO/SB/17 (01-08)

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 0.00**Complete if Known**

Application Number	08/765,108
Filing Date	March 27, 1997
First Named Inventor	Monty Krieger
Examiner Name	Michael T. Brannock
Art Unit	1649
Attorney Docket No.	MIT 6620 CIP

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CENTRAL FAX CENTER**FEB 08 2006****METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number 50-3129 Deposit Account Name: Pabst Patent Group LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Fee (\$)	Small Entity Fee (\$)
50	25
200	100
360	180

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
16	20 or HP =	0.00	0.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
7	7 or HP =	0.00	0.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x		

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): _____

SUBMITTED BYSignature Tiffany B. Salmon
Name (Print/Type) Tiffany B. SalmonRegistration No. 55,589
(Attorney/Agent)Telephone 404-879-2153Date February 8, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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MIT 6620 CIP 095148/19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Monty Krieger and Susan L. Acton

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FEB 08 2006**

Serial No.: 08/765,108

Art Unit: 1649

Filed: March 27, 1997

Examiner: Michael T. Brannock

For: *CLASS B1 AND C1 SCAVENGER RECEPTORS*Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**Response to Request by the Examiner for Sequence Listing Diskette and Support for
Inventorship**

Sir:

During the Examiner's telephone conversation with Patrea Pabst on January 31, 2006, the Examiner requested that a sequence listing diskette or a request to transfer the sequence listing diskette from the parent application be filed. The Examiner also requested copies of documents to support the change of inventorship.

Enclosed is a copy of the Preliminary Amendment filed December 23, 1996 requesting that Alan M. Pearson and Attilio Rigotti be deleted as inventors (see MPEP § 201.03). Also enclosed is a copy of the Office Action mailed March 5, 2002, in which the Examiner stated that the inventorship of the present application has been changed by deletion of Alan M. Pearson and Attilio Rigotti in view of the papers filed December 23, 1996 (see page 3 of the Office Action).

Pursuant to the Examiner's request, in accordance with 37 CFR 1.821(e), please use the computer readable form filed in U.S. Serial No. 08/265,428, filed June 23, 1994, by Monty

U.S.S.N.: 08/765,108
Filed: March 27, 1997
Response to Request by the Examiner for
Sequence Listing Diskette and Support for Inventorship

Krieger, Susan L. Acton and Alan Pearson as the computer readable form for the above-identified application. The paper copy of the Sequence Listing in the above-identified application is identical to the computer readable copy of the Sequence Listing filed in U.S. Serial No. 08/265,428, to which the present application claims priority. It is understood that the U.S. P.T.O. will make the necessary change in application number and filing date for the instant application. A paper copy of the Sequence Listing was included in the originally-filed specification of the instant application.

Declaration under 37 C.F.R. § 1.821(f)

I declare that the material in the prior Sequence Listing is identical to the paper copy of the Sequence Listing present in the above-identified application, that the Sequence Listing does not add new matter to the application, and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,



Tiffany B. Salmon
Reg. No. 55,589

Dated: February 8, 2006

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/765,108	03/27/1997	MONTY KRIEGER	MIT6620CIP	5650

7590

03/05/2002

PATREA L. PABST
HOLLAND AND KNIGHT LLP
ONE ATLANTIC CENTER
1201 WEST PEACHTREE STREET, SUITE 2000
ATLANTA, GA 30309-3400

EXAMINER

ULM, JOHN D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 03/05/2002

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Docketed for: ① 4-5-02 Rmchr
By: [Signature] ② 5-5-02 Rmchr
Date: 3-13-02 ③ 6-5-02 Rsp w/o cot
④ 7-5-02 Rsp w/1 cot
⑤ 8-5-02 Rsp w/2 cot
⑥ 9-5-02 Rsp w/3 cot
Drop Dead Date

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MAR 11 2002

PATENT DEPT.

Office Action SummaryApplication No.
08/765,108

Applicant(s)

Krieger et al.

Examiner

John Ulm

Art Unit

1646

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on BPAI remand of 09/25/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15, 19-22, and 44-50 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15, 19-22, and 44-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No.(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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I) Claims 11 to 15, 19 to 22 and 44 to 50 are pending in the instant application.

II) The instant application has been remanded to the examiner of record by the Board of Patent Appeals and Interferences for clarification of the outstanding issues, to afford Applicant an opportunity to respond to any rejections of record which might have been overlooked in the Appeal Brief and to apply a new reference based upon Applicant's admission during the oral hearing that was conducted on 16 August of 2001 that CD36 binds to LDL and acetylated LDL. The Board also indicated that Applicant may wish to use this opportunity to distinguish between the issues in the instant application and those principals which were expounded by the court in the decisions of *In re Bell*, 26 USPQ2d 1529, (Fed. Cir. 1993) and *In re Deuel*, 34 USPQ2d 1210, (Fed. Cir. 1995).

III) In view of the oral hearing held on 16 August of 2001, PROSECUTION IS HEREBY REOPENED. A restriction requirement and a new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111, because the finality of the action mailed 19 March of 1998 is withdrawn, or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132)

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or other evidence are permitted. See 37 CFR 1.193(b)(2). The appeal brief which was filed on 18 February of 1999 was defective because it did not address the three rejections listed as 6, 8 and 9 in the summary of rejections below. The supplemental brief must address the new grounds of rejection as well as the grounds of rejection listed as 8 and 9 in the summary of rejections.

IV) In view of the papers filed 23 December of 1996, the inventorship in this nonprovisional application has been changed by the deletion of Alan M. Pearson and Atilio Rigoti.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

V) The Board has expressed concern that Alan M. Pearson is listed as an Applicant on some of the correspondence in the instant application and, in particular, on the declaration under 35 U.S.C. § 1.132 which was submitted on 05 January of 1998. The inclusion of Alan M. Pearson and/or Atilio Rigoti in the list of "Applicants:" in the correspondence filed by Applicant should be of no consequence to the prosecution of the instant application since the inventorship of the **claimed** invention has been expressly identified by Applicant as Monty Krieger and Susan L. Acton in Paper Number 6, filed 23 December, 1996. Because the declaration under 35 U.S.C. § 1.132 was made by "the inventor" of the claimed subject matter to which it has been applied, it is unclear as to why the activities of Alan M. Pearson are of concern.

VI) The information disclosure statement which was filed on 05 May 1998 will not be considered because it is not in compliance with 37 C.F.R. § 1.97(d). Specifically, it was filed after

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a Final Rejection but was not accompanied by a certification as specified in 37 C.F.R. § 1.97(e), a petition and a petition fee. Further, it did not contain copies of the documents cited therein (37 C.F.R. § 1.98(d)(1) and it did not specifically identify that prior U.S. Patent Application from which priority is claimed and in which a copy of each of the cited document can be found.

VII) It is noted that either of claims 14 or 15 would be allowable if written in independent form without reference to those elements in the claims from which they depend, upon which rejections under 35 U.S.C. 112, second paragraph, have been based. For example, a claim to "an isolated nucleic acid molecule encoding the amino acid sequence of SEQ ID NO:4, 6 or 8" would be allowable.

VIII) The following is a summary of the outstanding grounds of rejection.

1) Claims 11 to 13, 19 to 22 and 44 to 50 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is not enabling for the production of an isolated nucleic acid encoding a scavenger receptor protein lacking one of the amino acid sequences that are disclosed in SEQ ID NOs:4, 6 and 8 of the instant application for those reasons of record as applied to claims 9 to 13, 15, 17, 19 to 22 and 44 to 50 in section 5 of Paper Number 10.

2) Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant specification does not provide an adequate written description of a nucleic acid which encodes a human scavenger receptor protein such that an

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artisan could make and use that nucleic acid, for those reasons of record in section 4 of Paper Number 10.

3) Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for those reasons of record in section 6 of Paper Number 10. This claim has been rejected because it is drawn to a method without steps. This claim requires the inhibition of a process but does not require the administration of any agent to achieve the required inhibitory effect and the instant specification does not provide the guidance needed to practice the claimed method without resort to substantial undue experimentation.

4) Claims 44 to 50 are rejected under 35 U.S.C. § 112, first paragraph, because they are incomplete for those reasons of record in section 7 of Paper 10. Each of these claims is drawn to a method and yet none of them recite sufficient elements to provide the claimed method.

5) Claims 11 to 15, 19 to 22 and 44 to 50 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are indefinite in so far as they recite the term "scavenger receptor protein type BI" as a limitation for those reasons of record in section 8.1 of Paper Number 10.

6) Claims 11, 12, 15, 19 to 22, and 44 to 50 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. These claims were vague and indefinite because the term "hybridizing" is a conditional limitation and no conditions are recited in these claims. This rejection is withdrawn in view of current patent practice. At the time that this rejection was made it was consistent with the patent practice in this art. However, current practice dictates that the recitation of nucleic acid hybridization in a claim in the absence of any hybridization conditions is to be treated as non-limiting because any nucleic acid will "hybridize" to any other nucleic acid under some conditions. Therefore, a claim which recites such a limitation is reasonably interpreted as encompassing any nucleic acid which meets all of the other limitations of the claim since that nucleic acid would meet the "hybridize" limitation solely by virtue of being a nucleic acid.

7) Claim 14 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for those reasons of record in section 8.4 of Paper Number 10.

8) Claim 21 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for those reasons of record in section 8.5 of Paper Number 10.

9) Claim 22 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for those reasons of record in section 8.6 of Paper Number 10.

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10) Claim 46 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for those reasons of record in section 8.7 of Paper Number 10.

11) Claims 11, 19 and 20 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by the Calvo et al. publication (J. Biol. Chem. 268(25):18929-18935, 05 Sept. 1993) for those reasons of record in section 9 of Paper Number 10.

12) Claims 21 and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over the Calvo et al. publication (J. Biol. Chem. 268(25):18929-18935, 05 Sept. 1993) for those reasons of record in section 10 of Paper Number 10.

IX) The following is a new grounds of rejection:

13) Claims 11 and 19 to 22 are rejected under 35 U.S.C. 102(b) as being anticipated by the Oquendo et al. publication (Cell 58:95-101, 14 July 1989). These claims encompass an isolated nucleic acid molecule which encodes a "scavenger receptor protein type BF" and which "hybridizes" to SEQ ID NOs: 3 and 7. As indicated in section 6 above, because the "hybridizes" limitation in these claims is unconditional, they encompass any isolated nucleic acid molecule which encodes a "scavenger receptor protein type BF". The text in the paragraph bridging pages 38 and 39 of the instant specification defines the term "scavenger receptor protein type BF" solely by function. Because Applicant conceded, during the oral hearing which was held on 16 August 2001, that CD36 meets the functional limitations of these claims then the instant claims

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encompass the isolated nucleic acid molecule which was described in Figure 4 of the Oquendo et al. publication more than a year before the filing of the instant application.

X) If Applicant chooses to reply to this action under 37 CFR 1.111, restriction to one of the following inventions is required under 35 U.S.C. 121 for further prosecution on the merits:

- I. Claims 11 to 15 and 19 to 22, drawn to an isolated nucleic acid molecule encoding a "scavenger receptor protein type BI" and a host cell containing that molecule, classified in class 435, subclass 252.3 and class 536, subclass 23.5.
- II. Claims 44 to 47, drawn to a binding assay, classified in class 435, subclass 7.2 and class 436, subclass 501.
- III. Claim 48, drawn to a method of treatment by administering a "scavenger receptor protein type BI", classified in class 514, subclass 2.
- IV. Claim 49, drawn to a method of treatment of undefined nature, classification undeterminable.
- V. Claim 50, drawn to a diagnostic assay, classified in class 436, subclass 536.

The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be employed as a probe to study the



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expression of the corresponding gene, which is a process that is unrelated to the binding assay that is invention II. Further, the assay of invention II, as claimed, can be practiced with a purified protein or with a cell which naturally expresses that protein, both of which are products that are materially different from the isolated nucleic acid molecule of invention I.

Inventions III, IV and V are unrelated to one another or to inventions I and II. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case inventions II to V are four different methods which achieve different objectives by employing different reagents and different steps, each having a different mode of operation. Further, the methods that are inventions III to V do not employ or produce the isolated nucleic acid molecule that is invention I.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter, and because the examination of these multiple inventions in a single application has proven to be an undue burden, restriction for further examination purposes as indicated is proper.

Applicant is advised that a reply under 37 CFR 1.111 to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800